REMARKS

Summary of the Response to Office Action

This Amendment responds to the Office Action mailed on March 26, 2007. Claims 1-16 stand rejected. Claim 2 has been canceled. The subject matter of claim 2 has been rewritten in independent form as claim 1. Claim 3 has been amended to recite more particular features of the nailing machine guide portion. Support for this amendment may be found, for example, on page 10, lines 5 to 18 of the specification as originally filed, and thus there is no issue of new matter. Claims 1 and 3-16 as amended are pending in this application. Examination and reconsideration of pending claims are respectfully requested.

Objections to the Specification Under MPEP 608.01(a)

In the Office Action, the title of the invention was objected to as not descriptive. Applicants respectfully disagree. Applicants have amended the title as suggested by the Examiner to recite "CYLINDRICAL CONTACT ARM HAVING A TAPERED GUIDE SECTION IN A POWER-DRIVEN NAILING MACHINE."

The specification was objected to as failing to provide proper antecedent basis for claimed subject matter. Applicants have amended the specification to reflect objected to terminology used in claims 8-16. There is no issue of new matter as the claims are believed to be fully supported by the specification and drawings as originally filed. *See e.g.*, Specification, FIGS. 1 and 4; pp. 9:15 to 10:18.

Rejections to the Claims Under 35 U.S.C. § 112

Claims 1-16 were rejected under 35 U.S.C. §112, second paragraph because the Examiner found the term "maximum sized nail" unclear. For the reasons set forth in the Amendment filed on December 26, 2006, Applicants respectfully disagree. Claims 1-16, however, have been amended without prejudice and reference to the term "maximum-sized nail" have been removed

for the purposes of expediting prosecution. Applicants reserve the right to pursue the cancelled claims in a continuation application.

Rejections to the Claims Under 35 U.S.C. § 102(b)

Claims 1-16 were rejected as anticipated by U.S. Patent No. 6,578,750 to Kubo et al ("Kubo").

Claims 1-4

Claims 1-4 were rejected for the same reasons set forth in paragraph 12 of the Office Action dated October 10, 2006. In that Office Action, the rejection stated:

> "The admitted prior art discloses the invention as claimed including a drive cylinder, driving piston and driver (all page 1), a nose body 30 and a contact nose 31 having a guide portion. The recitation "longer than a maximum sized nail" does not appear to define a specific length nail. Therefore the claims are deemed to be anticipated when AAPA is compared with a nail having length shorter than the length of the guide." Office Action dated October 12, 2006, p. 4, lines 15-20.

Claim 1 has been amended to remove the term "maximum sized nail" as described above. Additionally, claim 1 has been amended to incorporate the limitations of dependent claim 2. Claim 1 now recites, in part, a "contact nose including a *cylindrical portion* formed at its upper portion, *the nose body being housed in the cylindrical portion* such that the contact nose is held slidably along the nail discharge port of the nose body."

Neither the "AAPA" nor Kubo disclose a contact nose as recited by claim 1.

First, the rejection of claims 1-4 fails to articulate how the "AAPA" allegedly discloses a contact nose including a "cylindrical portion formed at its upper portion, the nose body being housed in the cylindrical portion," as now recited by claim 1 Thus, the rejection is insufficient to establish anticipation and should be withdrawn.

Second, referring to FIG. 7 of "AAPA" the alleged nose body 30 is not "housed in the cylindrical portion" of the alleged contact nose 31, and thus the "AAPA" does not disclose a "contact nose" as recited by claim 1.

Third, referring to FIGS. 1, 5 and 7 of Kubo, the upper portion of contact top 37 does not include a portion having the shape of a cylinder. Instead, the upper portion of contact top 37 forms a structure having a "C" shaped cross section due to a longitudinal opening or escape portion 45 that is formed within its upper portion. Because the "C" shaped structure does not define a cylinder in the upper portion of the contact top, Kubo fails to disclose a "contact nose including a *cylindrical portion* formed at its upper portion," as recited by clam 1.

For at least these reasons, the "AAPA" and Kubo fail to disclose a "contact nose including a cylindrical portion formed at its upper portion, the nose body being housed in the cylindrical portion such that the contact nose is held slidably along the nail discharge port of the nose body," and thus cannot anticipate claim 1.

Claims 3-7, which depend from claim 1, and are believed patentable over the cited references for the same reasons as claim 1, as well as for the particular features they recite. For example, claim 6 recites a contact nose that is "movable relative to the nose body such that in one configuration the nose body blocks movement of the contact nose *to actuate* the trigger." By contrast, Kubo discloses a nailing machine with a trigger mechanism that can be operated only through the operation of both of the trigger lever 33 and contact mechanism 34. Kubo, 5:4-7. Thus, Kubo fails to disclose the claimed "contact nose" or "nose body," and for this additional reason does not anticipate claim 6.

Claims 8-16

Claim 8 was rejected as anticipated by U.S. Patent No. 6,578,750 to Kubo et al ("Kubo"). The rejection stated in part:

> "A contact nose (36) includes a hollow member (45) that has proximal and distal ends (FIG. 1), inner and outer surfaces (FIG. 1), and is slidable relative to the nose body (26). A guide portion (36) forms a radial enclosure aligned with at least one nail." Office Action dated March 26, 2007, p. 4, lines 9-11.

Claim 8 has been amended to recite "a contact nose *having a leading end, the contact nose* including a hollow member with proximal and distal ends. Further, Claim 8 recites that

"the hollow member [defines] inner and outer surfaces extending from the proximal end to the distal end, *the fourth end of the nose body being circumferentially received within the proximal end of the hollow member* such that nose body is slidable relative to the hollow member between third and fourth positions, the second end resting on a first portion of the inner surface at the fourth position and being spaced from the first portion of the inner surface at the third position.

As described above in connection with claim 1, Kubo shows contact top 37 having an upper portion with a "C" shaped cross section due to escape portion 45. Because the "C" shaped structure does not completely encircle nose 26, the upper portion of contact top 37 fails to disclose a "nose body being *circumferentially received* within the proximal end of the hollow member," as recited by claim 8.

Moreover, claim 8 recites that "*the inner surface further [includes] a guide portion* disposed between the fourth position and the distal end, the *guide portion* being configured and dimensioned to form *a radial enclosure about the at least one-sized nail* such that the radial enclosure aligns the at least one-sized nail with the longitudinal axis of the driving cylinder before the driver pushes the at least one-sized nail out the leading end of the contact nose into the work piece."

Claim 8 was rejected, in part, because nose top 36 was found to correspond to the claimed "contact nose" and escape portion 45 was found to correspond to the claimed "hollow member." Office Action page 4, lines 9-11. The rejection states that "guide portion 36 forms a radial enclosure aligned with at least one nail." *Id.* at 12. Because the inner surface of the contact nose 36 disclosed by Kubo is not defined by escape portion 45, Kuba does not show a hollow member "*defining inner and outer surfaces..., the inner surface further including a guide portion,*" as recited by claim 8.

Finally, claim 8 recites, "a nail supply mechanism disposed between the driving cylinder and the fourth end of the nose body such that the nail supply mechanism supplies the at least one-sized nail to the nose body, *the nail supply mechanism being configured and dimensioned to accommodate only nails having a length less than or equal to the distance measured along the*

longitudinal axis from the leading end of the contact nose to a farthest extent of the radial enclosure. Kubo does not disclose such a nail supply mechanism.

For at least these reasons, Kubo fails to disclose a "contact nose" or a "nail supply mechanism," as recited by claim 8 and thus cannot not anticipate claim 8.

Claims 9-16, which depend from claim 8, are believed patentable over Kubo for the same reasons as claim 8, as well as for the particular features they recite. For instance, Kubo also fails to disclose a contact nose that is "movable relative to the nose body such that in one configuration the nose body blocks movement of the contact nose *to actuate* the trigger" as recited by claim 12. Instead, Kubo discloses that "trigger valve 32 can be operated only through the operation of both the trigger lever 33 and contact mechanism 34." Kuba et al. 5:4-7. *See also, Id.* at 3:16-21 and 5:26-29. Accordingly, Kubo further cannot anticipate claim 12.

Rejections to the Claims Under 35 U.S.C. § 103(a)

Claims 1-16 were rejected as being obvious over Kubo in view of U.S. Patent No. 1,241,996 to Kristiansen ("Kristiansen"). In addition to the reasons set forth in the Amendment dated December 26, 2006, Applicants respectfully disagree as follows.

Claims 1-7

As described above, Kubo fails to disclose a "contact nose including a cylindrical portion formed at its upper portion, the nose body being housed in the cylindrical portion such that the contact nose is held slidably along the nail discharge port of the nose body," as recited by claim 1. Kristiansen fails to remedy the deficiency of Kubo. Accordingly, even if one were motivated to combine these references as stated in the rejection, claim 1 would not be rendered obvious. Thus, claim 8 is believed to be allowable over Kubo or Kristiansen alone or in any combination.

Dependent claims 3-7, which incorporate the features of claim 1 are believed to be allowable over Kubo or Kristiansen for the same reasons as claim 1, as well as for the additional features recited by each dependent claim.

Claims 8-16

As described above, Kubo does not disclose a "contact portion" or a "nail supply mechanism" as recited by claim 8. Kristiansen fails to remedy the deficiency of Kubo, and thus even if one were motivated to combine these references as stated in the rejection claim 8 would not be rendered obvious. Thus, claim 8 is believed to be allowable over Kubo or Kristiansen alone or in any combination.

Dependent claims 9-16, which incorporate the features of claim 8 are believed to be allowable over Kubo or Kristiansen for the same reasons as claim 8, as well as for the additional features recited by each dependent claim.

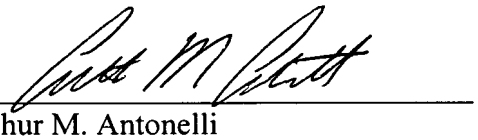
CONCLUSION

In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance, and thus request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: 

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Dated: July 25, 2007

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